

Remarks

Applicant presented claims 1 through 9 for examination. In the above-identified Office Action, the Examiner has rejected all of the Claims. In this Amendment, Applicant has deleted claims 1 and 8; amended claims 2, 3, 5, 7 and 9; and added claims 10-13. The antecedent bases of the amendments can be found, for example, in FIG. 2 and from line 19, page 5 to line 27, page 6 of the specification. Applicant has also included an Information Disclosure Statement with a set of documents. No new matters have been introduced.

Applicant appreciates the Examiner's comments in his Office Action to the above-identified application. For the reasons to be stated below, based on the amendments made, Applicant respectfully traverses the Examiner's rejections of the claims.

No Teaching, Suggestion and Motivation to Modify the '207 Patent

The original Claims 1-4 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,568,207, invented by Chao (the "207 Patent").

To reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness. *See In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995).

A prima facie case of obviousness requires setting forth:

- (a) the differences in the claim over the applied references,
- (b) the proposed modification of the applied references necessary to arrive at the claimed subject matter, and
- (c) an explanation why such proposed modification would be obvious. MPEP § 706.02.

"The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." *Libbey-Owens-Ford v. BOC Group*, 655 F. Supp., 897, 903; 4 USPQ 2d 1097, 1103 (DCNJ 1987). While it is permissible to modify a reference's disclosure in the examination

of patent applications, such modifications are not allowed if they are prompted by an applicant's disclosure, rather than by a reasoned analysis of the prior art and by suggestions provided therein. *In re Leslie*, 192 USPQ 427 (CCPA 1977).

The Examiner maintained that it would have been obvious for one of ordinary skill in the art to modify the frames taught in the '207 Patent to arrive at the original Claims 1-4. However, Claim 1 has been deleted, while Claims 2-3 have been amended to clarify the claimed limitations.

Each of the amended and newly added claims includes the following limitations: (a) the extensions or the arm of the auxiliary frame include(s) a rear end having a flange extended downward; (b) at least one flange of the auxiliary frame includes a magnet for engaging with a magnetic material of the primary frame; and (c) when the auxiliary frame is coupled to the primary frame, one flange is located either behind the stud or the bridge of the primary frame to reduce the likelihood of the auxiliary frame from being disengaged from the primary frame if the auxiliary frame is being pulled forward relative to the primary frame.

Nothing in the '207 Patent teaches or suggests modifying its frames to include one or more of Applicant's flanges. Nothing in the '207 Patent teaches or suggests having a magnet at such a flange. And nothing in the '207 Patent teaches or suggests reducing the likelihood of the auxiliary frame from being disengaged from the primary frame if the auxiliary frame is being pulled forward relative to the primary frame, due to the flange(s).

While in hindsight, the Examiner may feel that it would be obvious to modify the frames in the '207 Patent by adding in the flanges as in Applicant's inventions, such hindsight reconstruction is not a permissible method of constructing a rejection under 35 U.S.C. 103. *In re Warner and Warner*, 379 F.2d 1011, 1016 (CCPA 1967).

Since there is no proven evidence that the invention defined by its amended independent and dependent claims would have been obvious to one of ordinary skill in the art in view of the '207 Patent, Applicant traverses the finding that the claimed invention would have been obvious over the '207 Patent. Accordingly, the corresponding rejection in the Office Action with respect to the claims is traversed.

No Teaching, Suggestion or Motivation to Combine the '207 Patent and the '054 Patent

The original Claims 5, 6, 8 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over the '207 Patent in view of U.S. Patent Number 5,737,054, invented by Chao (the "054 Patent"). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *See In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *see also In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant has deleted Claim 8, and amended Claims 5 and 9, to clarify the claimed limitations. Nothing in either the '207 Patent or the '054 Patent teaches or suggests the use of flanges, as more clearly stated in the amended claims. Hence, it would not have been obvious to one of ordinary skill in the art to combine the '054 or the '207 Patent to arrive at the amended claims. As a result, Applicant traverses the finding that the claimed invention would have been obvious over the '207 Patent and the '054 Patent. Accordingly, the corresponding rejection in the Office Action is traversed.

The Amended Claim 7 Includes Limitations Not Taught in the '054 Patent

The original Claim 7 was rejected under 35 U.S.C. 102(e) as being anticipated by the '054 Patent. However, as discussed above, in view of a number of limitations in the amended Claim 7 not being found in the '054 Patent, such as the claimed flanges, this rejection has been traversed.

Terminal Disclaimers

The original claims 1-9 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending applications, with application numbers 08/848,129; 08/847,708; 08/847,707; 08/847,710; 08/848,101; and 08/847,709. To expedite the prosecution of the present application, Applicant has filed the attached terminal disclaimers.

Conclusion

In view of the above Amendments and Remarks, reconsideration of Claims 2-7 and 9 is requested and consideration of newly added Claims 10-13 is requested.

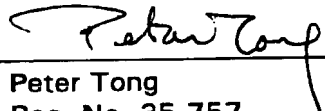
Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, July 29, 1998.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: July 29, 1998

By: _____


Peter Tong
Reg. No. 35,757

FLIESLER, DUBB, MEYER & LOVEJOY LLP
Four Embarcadero Center, Suite 400
San Francisco, California 94111-4156
Telephone: (415) 362-3800
July 15, 1998